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BRIEF FOR APPELLEE DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

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03-1530  
(Serial No. 09/054,565)

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IN RE JACK RICHARD SIMPSON

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Appeal from the United States Patent and Trademark Office,  
Board of Patent Appeals and Interferences.

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JOHN M. WHEALAN  
Solicitor

WILLIAM G. JENKS  
RAYMOND T. CHEN  
Associate Solicitors

P.O. Box 15667  
Arlington, Virginia 22215  
(703) 305-9035

*Attorneys for the Director of the  
United States Patent and  
Trademark Office*

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### **STATEMENT OF RELATED CASES**

The Director is not aware of any other appeal from the Board of Patent Appeals and Interferences in connection with application Serial No. 09/054,565 that has previously been before this or any other court. There is no other known related case pending in this or any other court. The Director notes, however, that Mr. Simpson has recently been before this Court on a different application (09/054,564) with similar claims and similar technology in appeal No. 02-1509. That case resulted in the unpublished decision *In re Simpson*, 2003 WL 1820138 (Fed. Cir. 2003).

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**I. STATEMENT OF THE ISSUE**

Simpson claims a rotary cutting die with three structural elements: (i) a base, (ii) a blade, which cuts scrap from a corrugated board, and (iii) a stripper, which assists in discarding the scrap. The Examiner and the Board found that Rilitz disclosed a rotary cutting die with the same three elements, albeit using different names: (i) clamp, (ii) knife, and (iii) guide. As to the various statements of intended use, e.g. the blade is for cutting scrap, the Board found that these were functional limitations that did not distinguish the claim over

Rilitz's cutting die because it could perform all the claimed uses. Thus, the Board found that Simpson's claims were anticipated by Rilitz.

Is the Board's factual finding that Rilitz anticipates Simpson's claims supported by substantial evidence?

## II. STATEMENT OF THE CASE

This appeal arose out of the examination of patent application Serial No. 09/054,565 filed by Jack R. Simpson. A23-56<sup>1</sup>. The examiner rejected representative claims 1 and 15 as anticipated by Rilitz<sup>2</sup>. A236-247. The Board affirmed the rejection of claims 1 and 15 based on Rilitz. A1-16. Simpson now appeals to this Court.

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<sup>1</sup> References to the Appendix are designated "A\_\_." References to Simpson's brief are designated "Br. at \_\_."

<sup>2</sup> The examiner also rejected the claims on several other grounds. The Board affirmed some of these other rejections and reversed others, however Simpson only appeals the rejection of representative claims 1 and 15 as anticipated by Rilitz. Hence, only this rejection will be addressed herein.



### III. STATEMENT OF THE FACTS

#### A. The Claimed Invention: A Rotary Cutting Die

Simpson's claimed invention is a rotary cutting die used to cut corrugated board. Representative claim 1 reads:

1. A rotary cutting die for cooperating with a rotary anvil to cut corrugated board comprising:
  - (a) a base;
  - (b) at least one scrap cutting blade secured to the base of the cutting die for cutting a piece of scrap from a sheet of corrugated board that is directed through a nip defined between the cutting die and the anvil;
  - (c) at least one scrap stripper mounted to the base adjacent the blade for stripping a cut scrap piece from the blade and for urging the cut scrap piece against the anvil as the cut scrap piece exits the nip;
  - (d) the at least one scrap stripper being constructed of a resilient material and including a base, a flexible finger integral with the base and extending outwardly therefrom at an angle, and an open area defined between the base and the flexible finger; and
  - (e) wherein the flexible finger is movable between a retracted position where it lies adjacent the base and an extended position where at least a portion of the finger is separated from the base.

A43 (emphasis added).

The claimed die has three main structural elements: (i) a “base”; (ii) a “blade”; and (iii) a “stripper”. A43. These limitations are further defined by what they can cut (the “blade” is for cutting scrap from a corrugated board) and what they can strip (the “stripper” is for stripping the unwanted scrap away from the blade). Sub-elements (d) and (e) of the claim further define the structure and function of the stripper.

One embodiment of the claimed die is shown in figure 1 of the specification (reproduced on the opposite page). A51. Corrugated board CB is fed into the gap, nip 64, between cutting cylinder 50 and anvil cylinder 60. The blades (unnumbered) of cutting die 52 cut into or through corrugated board CB and against the anvil cylinder 60 to produce a sheet or blank of finished corrugated board product. A32.

Simpson’s die 52 produces both the desired product board as well as unwanted scrap. The scrap is guided away from the product by scrap strippers 10. A33. One embodiment of Simpson’s claimed scrap stripper 10 is shown in isolation in figure 2 (reproduced opposite page). A52. Scrap stripper 10 includes base 12 and flexible angled finger 22. A33.

In addition to the claimed structure, Simpson’s claims also recite various

functional limitations. First, the claimed cutting die is capable of “cooperating with a rotary anvil to cut corrugated board.” A43. Second, the claimed blade is a “scrap cutting blade” capable of “cutting a piece of scrap from a sheet of corrugated board.” A43. And third, the claimed stripper is a “scrap stripper” capable of “stripping a cut piece of scrap from the blade” and “urging the cut scrap piece against the anvil.” A43.

These functional limitations are illustrated, for one embodiment of the claimed invention, in Simpson’s figures 4A-4E (reproduced on the opposite page). A53-55. In figure 4A, die 52 is rotating in cooperation with rotating anvil 60. A53. As die 52 rotates, corrugated board CB is cut by blade 54. A53-54, figs. 4B-4C. Finger 22 of scrap stripper 10 compresses to guide a portion of board CB away from blade 54 and urges it against rotary anvil 60. A54, figs. 4C-4D.

Simpson’s claim 15, also on appeal, is essentially the same as claim 1 except that it does not require that the claimed die be capable of “cooperating with a rotary anvil to cut corrugated board.” Br. at 30; A45.

#### **B. The Prior Art: Rilitz**

Rilitz discloses a rotating cutting apparatus for cutting paper “and/or

other relatively thin, flexible sheet materials.” A78, col. 1, lines 9-10. Rilitz’s apparatus, as shown in Rilitz’s figs. 1 and 2, includes two rotating drums 1a and 2a (reproduced on the opposite page). The examiner and the Board focused on the lower drum 2a in making their anticipation findings.

Rilitz’s lower rotating drum 2a includes three structural elements: (i) clamping device 7, (ii) knife 8, and (iii) guide 13. Clamping device 7 “engages and maintains” knife 8 in a fixed position on rotating cylinder 2a. A79, col. 4, lines 16-18. Knife 8 cuts the sheet materials fed between the rotating cylinders. A79, col. 3, line 67 - col. 4, line 14. Although only one knife is shown attached to lower rotary drum 2a, Rilitz discloses that more than one knife may be mounted on the drum. A80, col. 5, lines 48-49. Guide 13 (shown in the lower half of figure 2) has both a base attached to the clamping device and a finger (i.e., “an elongated lip-shaped deflector”) that extends outwardly over the base. A77, Fig. 2; A79, col. 4, lines 29-35. The finger portion of guide 13 acts to control the advance of the cut materials during and immediately after the cutting procedure. A80, col. 5, lines 36-47. Guide 13 is made of a resilient material, and the base and finger of the guide are integrally formed. A77, fig. 2; A79, col. 4, lines 30-33. The finger has a naturally

extended position where the end of the finger is separated from the base. A79, col. 4, lines 40-42. The finger is also movable to a retracted position where it lies adjacent the base. A77 Fig. 2; A79, col. 4, lines 30-33; A80, col. 5, lines 28-34.

### **C. The Board Decision**

The Board found that representative claim 1 was anticipated by Rilitz. First, because the Board found that all the claimed structural limitations were found in Rilitz. A7-8. The Board and the examiner found that the three main structural limitations claimed were disclosed in Rilitz as follows: (i) the claimed “base” was taught by Rilitz’s clamp 7; (ii) the claimed “blade” was taught by Rilitz’s knife 8; (iii) and the claimed “stripper” was taught by Rilitz’s guide 13. A6-8. Further, the Board affirmed the examiner’s conclusion that Rilitz’s guide 13 consists of two parts, a base and a flexible finger. Thus, these elements of the disclosed guide 13 met the structural limitations on the claimed stripper found in sub-elements (d) and (e) of claim 1. A6; A8; A317.

The Board next considered the functional limitations of claim 1. Both Simpson and the examiner recognized that claim 1 recites several functional limitations. A7-8; A315-16. Simpson argued to the Board that Rilitz does not

disclose “any number of functional limitations” including “a scrap cutting blade for cutting a piece of scrap” and that “in order to anticipate Rilitz would have to specifically show these limitations.” A289 (emphasis added). The examiner also interpreted the recited language as a functional limitation but found that Rilitz’s knife 8 could perform the “scrap cutting function.” A316. Further, the examiner argued that the limitation on intended use did not affect patentability so long as Rilitz could perform the function. A316. The Board found that the examiner’s arguments were correct and it also construed the claim language “for cutting a piece of scrap from a sheet of corrugated board” as functional language describing the capability of the claimed scrap cutting blade. A7-8.

The Board likewise followed the examiner and construed the claim language “for stripping a cut piece of scrap from the blade” and “for urging the cut scrap piece against the anvil” as functional limitations. A7-8, citing A315-18 in the examiner’s answer. Further, the Board construed claim 1’s recitation “for cooperating with a rotary anvil to cut corrugated board” as functional intended use language, and therefore the claim did not require an anvil or corrugated board:

Claims 1 and 15, however, recite a rotary cutting die per se, not a

rotary cutting die in combination with a cooperating anvil and/or a corrugated board, and not a method of cutting corrugated board passing between a rotary cutting die and an anvil.”

A8 (emphasis in original).

Further, the Board affirmed the Examiner’s findings that Rilitz was capable of performing these functions. A8. Based on its construction of the claim and its findings, the Board put the burden on Simpson to show that the lower rotary drum of Rilitz was not inherently capable of being used as a die cutter for cutting corrugated board as claimed by Simpson. A8. Simpson presented no evidence to the contrary, and the Board concluded that the claimed functional limitations were inherent. A8.

In sum, the Board construed claim 1’s limitations as either structural or functional. The Board then found that Rilitz disclosed each contested structural limitation in the claim and that Rilitz was capable of performing each contested functional limitation in the claim. As a result, and absent evidence to the contrary, the Board found that Rilitz anticipated Simpson’s claim. A6-8.

#### IV. SUMMARY OF THE ARGUMENT

Simpson's representative claim 1 recites a rotary cutting die with three main structural elements: (i) a "base," and attached thereto (ii) a "blade", which cuts scrap from a corrugated board, and (iii) a "stripper," which assists in discarding the scrap. The Examiner and the Board found that Rilitz disclosed a rotary cutting die with the same three elements, albeit using different names: (i) clamp 7, (ii) knife 8, and (iii) guide 13. In addition the Board found that Rilitz's guide satisfied additional structural limitations found in the representative claim. Specifically, Rilitz's guide is "constructed of resilient material" and includes two parts, a "base" and a "flexible finger integral with the base."

Simpson's claim also contains several non-structural, functional, limitations. These limitations describe how Simpson's rotary cutter is used. For example, the claim describes the blade as a "scrap cutting blade" that is used "for cutting a piece of scrap from a corrugated board." Likewise, the stripper is described as a "scrap stripper" that is used "for stripping a cut scrap piece from the blade." The Board and the examiner found that these functional limitations were inherent in Rilitz. Simpson has not provided any evidence to



rebut this fact finding. Thus, the Board found that Simpson's claims were anticipated by Rilitz.

This appeal is analogous to and supported by *In re Schreiber*. In *Schreiber*, the claimed "dispensing top" for "passing only several kernels of popcorn at a time" was anticipated by an oil funnel for "dispensing oil from an oil can" even though the terminology in the disclosure was quite different. Moreover, the oil funnel was inherently capable of performing the claimed popcorn-dispensing functions. Here the claimed rotary cutting die is anticipated by Rilitz rotary cutting drum because Rilitz's drum, despite the different terminology, has the same structure and is inherently capable of performing the various functions claimed by Simpson.

*Schreiber* also makes clear that, where the Office identifies prior art with the claimed physical structure, the burden shifts to the applicant to show that the claimed functions are not inherent in the prior art. Here, Simpson has not presented any evidence to rebut the Board's inherency findings. Instead, Simpson argues that the Board improperly construed the claims by reading certain limitations, e.g., the anvil, as functional limitations. This argument fails because the Board interpretation of the limitation a "cutting die for cooperating

with a rotary anvil” as functional and not requiring an anvil as part of the claimed die is reasonable. The terms “for cooperating with” show that Simpson claims the die, with the recited capability, not the die and anvil in combination. Likewise, the remaining functional limitations were properly interpreted as functional.

## V. ARGUMENT

### A. Standard of Review

Representative claims 1 and 15 stand rejected as anticipated under 35 U.S.C. § 102. Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). In order for a reference to anticipate a claim, it must disclose every limitation in the claim either inherently or explicitly. *Id.* Whether a reference inherently discloses a limitation is a question of fact. *Id.* The Board’s decisions on factual matters are upheld if there is substantial evidence in the record to support the Board’s findings. *In re Gartside*, 203 F.3d 1305, 1315 (Fed. Cir. 2000).

Substantial evidence is “such relevant evidence as a reasonable mind might accept as accurate to support a conclusion.” *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938). As this Court recently stated, “where two

different, inconsistent conclusions may reasonably be drawn from the evidence in record, an agency's decision to favor one conclusion over the other is the epitome of a decision that must be sustained upon review for substantial evidence." *In re Jolley*, 308 F.3d 1317, 1329 (Fed. Cir. 2002).

Claim construction is a question of law reviewed *de novo* on appeal. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998) (en banc). Since claims during prosecution must be given their "broadest reasonable interpretation," this Court reviews the USPTO's interpretation of disputed claim language to determine whether it is "reasonable" in light of all the evidence before the Board. *In re Morris*, 127 F.3d 1048, 1055 (Fed. Cir. 1997).

**B. Substantial Evidence Supports the Board's Finding That Rilitz's Rotary Cutting System Anticipates Simpson's Claimed Rotary Cutting Die**

In order for Rilitz to anticipate the claimed invention it must disclose every limitation of the claim either inherently or explicitly. *Schreiber*, 128 F.3d at 1477. Simpson is free to claim his apparatus in terms of its structure or function. *Id.* at 1478 (quoting *In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971)). If, however, the USPTO determines that the claimed function is an

inherent characteristic of the prior art, then the burden shifts to Simpson to disprove this fact. *Schreiber*, 128 F.3d at 1478. Inherent characteristics of the prior art include the inherent capability to perform a claimed function. *Schreiber*, 128 F.3d at 1477. Here, as detailed below, the Board properly found that Rilitz discloses every claimed structural element and is inherently capable of performing every claimed function. The burden then shifts to Simpson, who has not provided an evidence to the contrary.

**1. Rilitz discloses all three structural elements claimed**

Simpson's claimed die has three structural limitations: (i) a base, (ii) a blade, and (iii) a stripper. The stripper is made of a resilient material and consists of two parts, flexible finger and a base. A43; A8.

Rilitz discloses these three elements as well, albeit using different terminology. Referring to Rilitz figure 1, Rilitz shows a rotary cutting die in drum-shaped holder 2a. The drum-shaped holder identified by the examiner and the board is the lower of the two rotating drums.<sup>3</sup> Attached to the drum is a base that Rilitz refers to as clamping device 7 or clamp 7. The base supports

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<sup>3</sup> Presumably, the examiner and the Board could have relied on the upper drum shaped holder 1a to find anticipation as it is nearly identical to rotary drum 2a.

a blade that Rilitz refers to as knife 8. The base also supports a stripper that Rilitz refers to as guide 13. A7-8; A79, col. 4, lines 14-37. Furthermore, like the claimed scrap stripper, guide 13 is made of a resilient material. A79, col. 4, lines 30-33. And guide 13 has two parts, a base and a flexible finger. Guide 13 is shown by the cross-hatching in Rilitz's figure 2, reproduced on the opposite page. Rilitz's stripper 13 has its own base secured to the die's base (clamping device 7) and a finger extending outwardly at an angle. A77, Fig. 2; A79, col. 4, lines 33-42. Simpson argues that Rilitz's guide 13 is only the finger and is not integrally formed with the base. But the guide finger and guide base are labeled with a single number and they are similarly cross-hatched in contrast to clamp 7 and blade 8. Therefore, the examiner was correct in finding that Rilitz's guide 13 is a single integral piece and the Board correctly affirmed that the guide meets the structural limitations of the claimed stripper. A317; A8.

**2. Rilitz is capable of performing all the claimed functions**

Simpson's claimed die also has several functional elements. Because Rilitz discloses all of the claimed structure, the examiner and the Board are entitled to presume that this identical structure is capable of performing the

claimed functions. *Schreiber*, 128 F.3d at 1478, citing *Swinehart* 439 F.2d at 213. But the examiner and the Board did not simply rely on the *Schreiber* presumption. Instead they made factual findings with respect to the functional limitations and demonstrated that Rilitz is capable of performing all the claimed functions.

The examiner found, and the Board affirmed, that Rilitz's rotary cutter is capable of performing each of the functions claimed. A316-17; A7-8. In particular, the examiner found that Rilitz knife 8 was capable of "cutting scrap" because the stock used in Rilitz itself would naturally be cut by knife 8 into product pieces and waste or scrap pieces. A316. The examiner also found that Rilitz's guide 13 was capable of "stripping the cut scrap piece" from knife 8 because guide 13 guides all the cut pieces in Rilitz away from the blades of the die. A316. Likewise, the examiner found that guide 13 was capable of "urging the cut scrap piece" against a cooperating anvil because, in Rilitz, guide 13 functions to urge the cut scrap against the other guide, which is located on the opposing rotating drum. A317, citing A80, col. 6, lines 12-32. Were the upper drum to be replaced by a cooperating anvil, guide 13 would urge the cut scrap against that anvil. These findings, affirmed by the Board, A7-A8, demonstrate

that, even without the *Schreiber* presumption, the claimed functions are apparent in Rilitz.

The following claim chart illustrates how each of the structural elements of claim 1 are found in Rilitz and applied by the Board and the examiner. The chart also shows each claimed function and how that function is inherent in Rilitz as detailed in the next section.

Representative Claim 1	Prior Art Rilitz
1. A rotary cutting die for cooperating with a rotary anvil to cut corrugated board comprising:	The lower drum in Rilitz Fig. 2 is a rotary carrier 2a with knife 8. A7; A77, Fig. 2.
(a) a base;	Rilitz Fig. 2 shows “clamping device 9, 7 which engages and maintains the respective knife 11, 8...” A7; A77, Fig. 2; A79, col. 4, lines 16-18. A6.
(b) at least one scrap cutting blade secured to the base of the cutting die for cutting a piece of scrap from a sheet of corrugated board that is directed through a nip defined between the cutting die and the anvil;	Rilitz Fig. 2 shows knife 8, which is capable of cutting scrap from a sheet of corrugated board. A7-8; A77, Fig. 2; A79, col. 3, line 67 - col. 4, line 14.

(c) at least one scrap stripper mounted to the base adjacent the blade for stripping a cut scrap piece from the blade and for urging the cut scrap piece against the anvil as the cut scrap piece exits the nip;	Rilitz deflector/guide 13 is mounted to clamping device 7. A77 Fig. 2; A79, col. 4, lines 40-49. Deflector 13 is capable of stripping scrap from knife 8. A6; A7-8.
(d) the at least one scrap stripper being constructed of a resilient material and including a base, a flexible finger integral with the base and extending outwardly therefrom at an angle, and an open area defined between the base and the flexible finger; and	Rilitz's guide 13 is made of "elastomeric material," has a base, and a flexible finger integral with the base. A6; A77, Figs. 1, 2; A79, col. 4, lines 30-33; A317. The flexible finger extends outwardly from the base at an angle, and an open area is defined between the base and the flexible finger. A77, Figs. 1, 2; A79, col. 4, lines 40-42.
(e) wherein the flexible finger is movable between a retracted position where it lies adjacent the base and an extended position where at least a portion of the finger is separated from the base.	The flexible finger of Rilitz's guide naturally has an extended position where it is separate from the base. A77, Figs. 1, 2; A79, col. 4, lines 40-42. The flexible finger, being made of an elastomeric material, is movable to a retracted position where it lies adjacent the base. A6; A79, col. 4, lines 30-33; A77, Fig. 2; A317.

**3. Simpson has provided no evidence to rebut the presumption that Rilitz is inherently capable of performing the claimed functions**

Once the examiner and the Board demonstrated Rilitz discloses all of



the claimed structure, the burden shifted to Simpson to show that Rilitz cannot perform the claimed functions. *Schreiber*, 128 F.3d at 1478, citing *Swinehart* 439 F.2d at 213. *Id.* This he has not done. A8; A. Thus, even absent the extensive fact finding on the functional limitations by the Board and the examiner, the Board's finding that Rilitz meets the functional limitation under principles of inherency should be affirmed.

Simpson's brief to the Board provides no evidence that Rilitz's identical structure is incapable of performing the recited functions. A288-291. Simpson has not provided any testing of the Rilitz apparatus, or any expert affidavits that demonstrate that the apparatus could not be used for the claimed functions. Instead he relies on the argument that because Rilitz does not disclose the specific functions claimed it cannot anticipate the functional language in the claim. A289; Br. at. 18, 27-29.

**4. The Board's decision is fully supported by this Court's decision in *Schreiber***

In *Schreiber*, the applicant attempted to claim a known funnel structure with an "enlarged end" and a "reduced end" as a popcorn dispenser.

*Schreiber*, 128 F.3d at 1475. The anticipating reference disclosed a funnel

with the claimed structural elements but Schreiber argued his claimed “dispensing top” was distinguished by the functional claim limitation that it was shaped to “permit the dispensing of only a few kernels at a shake.” The Court agreed that the reference did not expressly disclose using the oil funnel for dispensing popcorn but rejected the notion that the prior art must explicitly disclose the claimed function. *Id.* at 1477. Instead, noting that an applicant’s choice to claim functionally carries with it a risk, the Court placed the burden on Schreiber of showing “that the prior art structure did not inherently possess the functionally defined limitations of his claimed apparatus.” *Id.* at 1478. Since Schreiber failed to produce evidence sufficient to meet that burden, the Court ruled that the *prima facie* case was not rebutted and affirmed the anticipation rejection. *Id.* at 1479.

Here, Simpson likewise claims much of his cutting die in functional terms but presented no evidence to rebut the presumption that the prior structure can inherently perform the recited functions of cutting scrap, cooperating with an anvil, and stripping scrap.

A close comparison of Schreiber’s claim to Simpson’s claim illustrates the strong similarities between the claims, thereby underscoring why the same

legal principles applied in *Schreiber* should apply here. Schreiber's claim 1 read:

1. A dispensing top for passing only several kernels of popped popcorn at a time from an open-ended container filled with popped popcorn, having a generally conical shape and an opening at each end, the opening at the reduced end allows several kernels of popped popcorn to pass through at the same time, and means at the enlarged end of the top to embrace the open end of the container, the taper of the top being uniform and such as to by itself jam up the popped popcorn before the end of the cone and permit the dispensing of only a few kernels at a shake of a package when the top is mounted on the container.

*Schreiber*, 128 F.3d at 1475 (emphasis added). Just like Simpson's claim, Schreiber's claim is a combination of structural elements, "a conical shape", "an opening at the reduced end," etc., and functional limitations, e.g., for passing only several kernels of popped popcorn at a time. Both Schreiber and Simpson argued that the functional language used throughout their respective claims conveyed patentability on a known structure. Here, however, as in *Schreiber*, the Board properly rejected that argument, finding that Rilitz's rotary cutter was inherently capable of those functions and Simpson failed to rebut that prima facie finding. A8

Simpson contends that Board's conclusion that the inherent capability of

Rilitz provided a sufficient basis for anticipation was “a misstatement of the law of inherency.” Br. at 11. This contention ignores this Court’s principle of inherent capability as laid out in *Schreiber*. See also, *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990); *Titanium Metals Corp. Of Am. v. Banner*, 778 F.2d 775, 782 (Fed. Cir. 1985).

Furthermore, Simpson’s position is not supported by his citations to *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993), and *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999). In *Rijckaert*, the Board improperly found that a prior art signal processing circuit in an obviousness rejection had certain characteristics. The Board’s error was in assuming physical elements in the circuit that would lead to the characteristics. 9 F.3d at 1533-34. In *Robertson*, the claimed invention required three fasteners, but the prior art applied by the Board only had two fasteners. *Robertson*, 169 F.3d at 744. The Board ruled that since the two fasteners of the prior art could perform the function of the third fastener, the third fastener was inherent. *Id.* at 745. This Court reversed, stating that the third fastener was an independent structural element that must be present. *Id.*; see also *Id.* at 746 (Rader, J., concurring).

Here, unlike the cases cited by Simpson, the Board’s rejection of

Simpson's claims is based on the inherent capability of Rilitz's shown structure to perform the claimed function. All of the structural elements relied on by the Board, clamp 7, knife 8, and guide 13, are present in Rilitz.

Simpson states that "[t]here is nothing in Rilitz or the prior art in general that would suggest that a device like Rilitz could be used as a die cutter to cut and eject scrap from corrugated board." Br. at 29. Whether or not this statement is true is irrelevant, since the present case is not an obviousness rejection based on modifying the Rilitz device to meet the claim limitations. Inherency is not dependent upon whether ordinary artisans would have recognized the inherent characteristics or functioning of the prior art. *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999).

### **C. Claim 15 Is Likewise Unpatentable**

Turning to claim 15, Simpson acknowledges that it recites essentially the same limitations as claim 1, except that claim 15 does not require that the claimed die be capable of "cooperating with a rotary anvil to cut corrugated board." Br. at 30; A45. To the extent there is a difference, claim 15 is slightly broader than claim 1 because of the missing functional element. Therefore, if claim 1 is unpatentable then claim 15 is unpatentable. This Court need only

reach the patentability of claim 15 if it reverses the Board on claim 1 and bases that reversal solely on the “cooperating with a rotary anvil” element. Otherwise, claim 15 is anticipated by Rilitz for the same reasons claim 1 is anticipated.

**D. Simpson’s Arguments Do Not Overcome the Board’s Findings**

**1. The Board properly construed the contested claim terms**

Simpson now argues that the Board erred because it “wholly bypassed claim construction,” citing *Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997). Br. at 20-22. However, *Gechter* requires analysis “as to any construction disputed by the parties” and “fact findings for each contested limitation.” *Gechter*, 116 F.3d at 1460 (emphasis added). Moreover, as explained in *In re Hyatt*, 211 F.3d 1367, 1371 (Fed. Cir. 2000), the “central thrust of *Gechter* is that the Board must explain the basis for its rulings sufficiently to enable meaningful judicial review.”

A close review of the relevant sections of (i) Simpson’s brief to the Board (A288-91), (ii) the examiner’s answer (A310; A315-18), and (iii) the Board decision (A5-9) shows that Simpson’s main dispute with the examiner was whether the reference must explicitly disclose the functional limitations.

Simpson argued that Rilitz cannot anticipate his claim because the claimed functions are not specifically taught:

There are any number of functional limitations positively recited in the claims that is not found in Rilitz. In the way of examples, claim 1 calls for a scrap cutting blade for cutting a piece of scrap from a sheet of corrugated board. Rilitz does not disclose this limitation. Further claim 1 recites at least on scrap stripper for stripping a cut piece of corrugated board from the blade and urging the cut scrap of corrugated board against the anvil. These limitations are found in all of the claims. In order to anticipate Rilitz would have to specifically show these limitations,”

(A289, emphasis added). The examiner answered that these functional limitations were merely a statement of intended use and cannot make a prior art apparatus newly patentable. A315-16

The Board sufficiently construed Simpson’s claim to resolve this dispute, by dividing the claim into structural and functional limitations and concurring with the examiner’s findings concerning the meaning of claim terminology. A6-A8; A316-17. The Board’s analysis then went to (i) whether the disputed structural limitations were disclosed in Rilitz and (ii) whether Rilitz is inherently capable of performing the recited functions. This is exactly the type of analysis required by *Gechter* and *Hyatt*, especially given how Simpson chose to argue his case to the Board.

Put another way, Simpson's primary dispute with the examiner before the Board was that his claimed device is used to cut a different thing than Rilitz's device. The Board explained that this does not necessarily make the claim patentable. Further, that Rilitz discloses the claimed structure and is inherently capable of cutting the claimed material in the claimed way. Although Simpson may not like the Board's conclusion, he has provided no evidence to the contrary. Until he does, the fact finding by the examiner and the Board stand unrebutted.

**2. Simpson's claimed apparatus does not include the structural elements he argues**

Simpson also argues that the Board's anticipation finding is wrong because Rilitz fails to show structure as described in Simpson's specification. Br. at 13-19. But "the name of the game is the claim" not the specification. *In re Hiniker*, 150 F.3d 1362, 1369 (Fed. Cir. 1998). And substantial evidence supports the Board's finding that Rilitz anticipates Simpson's claimed invention.

**a. Simpson does not claim an anvil**

Simpson states that the Board considered Rilitz's lower conveyor 2 to



inherently be an anvil (Br. at 17), but Simpson misinterprets the Board's rejection. The Board explained that it read Simpson's claim 1 only to be reciting a rotary cutting die, not a rotary cutting system comprising a die and an anvil. A8. As a result, the Board concluded that Rilitz's cutting apparatus (lower drum 2a) was inherently capable of acting against an anvil (as opposed to a second cutting apparatus as shown in Rilitz's figure 1), thus anticipating the claimed invention. If Simpson instead had claimed a rotary cutting system, comprising a rotary cutting die and an anvil, the situation would be different. Instead, Simpson broadly claims the rotary cutting die alone, and thus the Board's finding that Rilitz discloses the cutting die as claimed is supported by substantial evidence.

Simpson similarly argues that the Board improperly read the preamble term "rotary anvil" out of his claim. Simpson relies on *Pitney Bowes, Inc. v. Hewlett Packard Co.*, 182 F.3d 1298 (Fed. Cir. 1999) to demonstrate that this preamble term must be deemed a limitation and given patentable weight. Br. at 26. Simpson's argument is misdirected. The Board did not read the term "anvil" out of the claim because it appeared in the preamble. Rather, the Board read this part of the preamble, "[a] rotary cutting die for cooperating with a

rotary anvil” as a functional limitation, limiting the claimed die to being capable of “cooperating” with an anvil. Thus, the Board did not disregard the preamble language, but instead properly analyzed it as a functional limitation.

**b. Simpson’s other structural arguments also fail**

Now Simpson, for the first time on appeal, cites to dictionary definitions of “die” and “scrap” and argues that his claimed die “cannot be given a reasonable interpretation that is so broad as to encompass the cutting device of Rilitz,” Br. at 14-15. Because Simpson never argued this point to the Board he cannot now argue this point as a basis for overturning the Board’s decision.<sup>4</sup>

*Hyatt*, 211 F.3d at 1373.

Even if Simpson had raised this argument below it would nevertheless fail because the definition he now proffers and the structure he cites from his

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<sup>4</sup> In his appeal brief to the Board, Simpson stated “the Rilitz et al. patent does not relate to a die cutter for cutting corrugated board and certainly does not relate in any way to cutting and ejecting scrap from such a corrugated board. There are any number of functional limitations positively recited in the claims that is [sic] not found in Rilitz.” A289 (emphasis added). Simpson proceeded to explain that the reason why Rilitz did not relate to a die cutter was because Rilitz failed to disclose the functional limitations, namely cutting and ejecting scrap. A289. Simpson never argued to the Board that Rilitz’s cutting cylinder did not meet the structural limitations of a die. A288-291. Since this argument was not made, the Board did not address it. A5-A9.

specification would necessarily exclude the die he claims. Simpson argues that his claimed rotary cutting die means a device that comprises two cutting blades. Br. at 15 (“Throughout the specification the rotary cutting die is described as a device that includes scrap cutting blades 54, 56....”). But Simpson’s claim is not that narrow. Simpson does not claim “a rotary cutting die... comprising at least two scrap cutting blades,” or “a rotary cutting die ... comprising a pattern of blades for cutting out material.

Instead, Simpson’s claimed die requires only “at least one scrap cutting blade.” Simpson cannot overcome Rilitz by engaging “in a *post hoc* attempt to redefine the claimed invention by impermissibly incorporating language appearing in the specification into the claims.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). Accordingly, Rilitz, which has only one cutting blade, meets the cutting blade limitation of Simpson’s claimed invention. Further, Rilitz actually discloses that each rotary drum 1a and 2a can be provided with multiple blades. A80, col. 5, lines 48-49.

Simpson argues that the Board ignored the term “scrap” as it modifies the “scrap cutting blade” and “scrap stripper” because Rilitz never cuts any scrap but only product pieces from a web. This is incorrect. The examiner

found that Rilitz's knife 8 would be acting as a scrap cutter at any point in which unwanted material (i.e. scrap) was being cut from the stock and he concluded that Rilitz's actual purpose was irrelevant, since Rilitz was inherently capable of cutting scrap from a piece of corrugated board. A316. Again, and to the extent multiple blades would be required before scrap could be cut, Rilitz discloses the use of multiple blades on its lower rotary drum 2a. A80, col. 5, lines 48-49.

## VI. CONCLUSION

Substantial evidence supports the Board's findings that Rilitz discloses each structural element of representative claim 1 and is inherently capable of performing the claimed functions. Simpson has proffered no evidence to the contrary. Therefore, this Court should affirm the Board's decision that the claims are anticipated by Rilitz.

Respectfully Submitted,

A handwritten signature in cursive script, appearing to read "William G. Jenks", is written over a horizontal line.

January 15, 2004

JOHN M. WHEALAN  
Solicitor

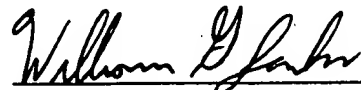
WILLIAM G. JENKS  
RAYMOND T. CHEN  
Associate Solicitors

P.O. Box 15667  
Arlington, Virginia 22215  
(703) 305-9035

*Attorneys for the Director of the  
United States Patent and  
Trademark Office*

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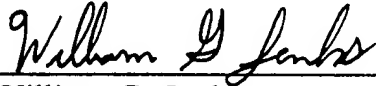
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William G. Jenks  
Associate Solicitor

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I hereby certify that on January 15, 2004, I caused two copies of the foregoing BRIEF FOR APPELLEE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE and CERTIFICATE OF COMPLIANCE to be transmitted via overnight express, addressed as follows:

Larry L. Coats  
COATS & BENNETT, PLLC  
1400 Crescent Green  
Suite 300  
Cary, NC 27511  
(919) 854-1844

  
\_\_\_\_\_  
William G. Jenks  
Associate Solicitor  
U.S. Patent and Trademark Office  
P.O. Box 15667  
Arlington, Virginia 22215  
703-305-9035